

REMARKS

Claims 1-6 and 11-14 have been examined. With this amendment, Applicants cancel claims 1, 11 and 13 and add claim 15. Claims 2-6, 12, 14 and 15 are all the claims pending in the application.

I. Formalities

Applicants thank the Examiner for indicating that the drawings have been accepted. However, the Examiner incorrectly states that the drawings were filed on January 25, 2002, instead of October 22, 2001. Applicants request that the Examiner correct this in the next Office Action.

II. Claim Rejections - 35 USC § 102

The Examiner has rejected claims 1-2, 4, 11, and 13 under 35 U.S.C. § 102(b) as being anticipated by Seki *et al.* (US 6,056,451) [“Seki”].

Applicants cancel claims 1 and 13 without prejudice or disclaimer. Applicants have changed the dependency of claims 2 and 4. The rejection of claims 2 and 4 will be addressed below.

III. Claim Rejections - 35 U.S.C. § 103(a)

The Examiner has rejected claims 3, 5 and 12 under 35 U.S.C. §103(a) as being unpatentable over Seki in view of Shiota. For at least the following reasons, Applicants traverse the rejection.

Claim 5 recites an image reading apparatus that comprises “a transport switching section ... for switching between a state in which the photographic film transported by the film transporting portion is guided to the reading transport path, and a state in which the photographic film transported from the reading transport path to the transport merging portion by the reading transporting portion is guided to the film output path.” The Examiner concedes that Seki does not disclose this feature but applies Shiota to allegedly cure the deficiency.

The Examiner contends that film feed rollers 86 correspond to the claimed transporting switching section. Shiota discloses that film feed rollers 86 are used in the unwinding and rewinding of the film from/to the cartridge 30 as it is transported to/from the exposure unit (see Fig. 4, col. 6, lines 44-49).

The Examiner also contends that the claimed transportation to the reading transport path is performed by transporting feeding section 40, which, in essence, is the unwinding of the film from cartridge 30. The Examiner does not specifically indicate which feature in Fig. 4 allegedly corresponds to the claimed transport from the reading transport path to the transport merging portion, but since film feed rollers 86 (the alleged transporting switching section) only transport in two directions, the other direction (i.e., rewinding of the film into cartridge 30) must allegedly correspond to the claimed transport from the reading transport path to the transport merging portion.

The Examiner contends that one skilled in the art would have been motivated to incorporate the film feed rollers 86 into the invention in Seki because it is “an efficient way to utilize the film loader.” Office Action at page 6.

Shiota relates to a photofinishing system where photographic films are individually wound into cartridges after development (col. 1, lines 10-11). Seki relates to a film processing apparatus for processing a long developed photographic film by joining a plurality of films with a splicing material (col. 1, lines 6-9, Fig. 2).

Although both apparatus may transport film to exposure devices, the film feeding section 40 of Shiota and the transport device 40 of Seki perform different functions due to the difference in the initial packaging of the films (i.e., individual films in cartridges vs. a plurality of film on a film roll). For example, the invention in Shiota retracts the film back into its cartridge after processing by the exposure device (col. 6, lines 44-49), whereas the invention in Seki cuts each film and transports it to the exposure processing unit (col. 1, line 65 to col. 2, line 10). Accordingly, the invention in Seki cannot retract the film back onto its film roll.

Applicants submit that, due to the inherent differences in the initial packaging and the subsequent processing of the films, Seki and Shiota are non-analogous art with respect to any teachings related to the film feeding section 40 of Shiota and the transport device 40 of Seki. Accordingly, one skilled in the art would not have combined the references as contended by the Examiner.

In addition, the rewinding operation, which allegedly corresponds to the claimed transport from the reading transport path to the transport merging portion, by film transport feeding section 40 and film feed rollers 86 is not needed in the invention of Seki. In fact, modifying the invention of Seki would change its principle of operation.

Seki requires cutting the film in order to eliminate inefficient film processing (col. 1, lines 50-55) by selectively transporting films to the reading unit 20 that are fit for processing (see col. 2, line 63 to col. 3, line 7, Fig. 2) and averting processing on films that are unfit for processing (col. 3, lines 7-17). Modifying Seki to incorporate the rewinding feature of film transport section 40 and film feed roller 86 as suggested by the Examiner would frustrate the efficient processing objective of Seki since, as disclosed by Seki, averting processing on unfit film requires that the film be cut and diverted along a separate path (see Figs. 2, 7A and 7B, element 90).

Accordingly, since the principle of operation for the invention would be modified, the Examiner has not made a *prima facie* case of obviousness for this additional reason. See MPEP 2100-132 (Proposed modification cannot change the principle of operation of a reference).

Applicants submit that claims 2-4 and 12 are patentable at least by virtue of their dependency on claim 5.

In addition, with respect to claim 3, since film reservoir 81 (loop) relates to facilitating the rewinding of film 12a, 13a back into cartridge 30 (col. 6, lines 44-49), Applicants submit that film reservoir 81 is irrelevant to the invention in Seki since the invention in Seki does not rewind the film back onto film roll 1.

Accordingly, one skilled in the art would not have combined the teachings as suggested by the Examiner, and claim 3 is patentable for this additional reason.

The Examiner has rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Seki in view of Nakamura (US 6,470,101 B1) [“Nakamura”]. For at least the following reason, Applicants traverse the rejection.

Claim 14 recites an image reading apparatus “wherein the image reading section has a film take-up section which takes up the photographic film such that the photographic film which has been subject to the pre-scanning is accommodated to the film take-up section, thereafter, the photographic film which has been subject to the pre-scanning is conveyed from the film take-up section in order to be subject to the fine scanning.” The Examiner takes official notice that pre-scanning and fine-scanning are known in the art and cites Nakamura in support.

Applicants submit that, even if these features are known, their combination with the claimed directions is not rendered obvious by Seki in view of Nakamura since pre-scanning and fine-scanning may be done in the same direction.

The Examiner has rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Seki and Shiota in view of Nakamura. For at least the following reasons, Applicants traverse the rejection.

Claim 6 recites an image reading apparatus “wherein the image reading section performs a prescanning for preliminary reading the image on the photographic film when the photographic film is transported from one end of the reading transport path, which is located at a side of the transport merging portion, to another end of the reading transport path, and the image reading section performs a fine scanning for finely reading the image on the photographic film on the basis of image information obtained by the prescanning when the photographic film is

transported from the other end of the reading transport path to the one end of the reading transport path.” The Examiner takes official notice that pre-scanning and fine-scanning are known in the art and cites Nakamura in support.

Applicants submit that, even if these features are known, their combination with the claimed directions is not rendered obvious by Seki and Shiota in view of Nakamura since pre-scanning and fine-scanning may be done in the same direction.

In addition, because Nakamura does not cure the deficient teachings of Seki and Shiota with respect to claim 5, Applicants submit that claim 6 is patentable at least by virtue of its dependency on claim 5.

IV. New Claims

With this amendment, Applicants add claim 15. Applicants submit that claim 15 is patentable at least by virtue of its dependency on claim 5, as well as the features set forth therein.

V. Conclusion

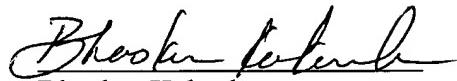
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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